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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,357	01/11/2002	Wayne A. Provost	14689.12	8202

22913   7590   03/03/2006

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER
TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/044,357	PROVOST ET AL.
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 January 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>11 January 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>18 March 2002</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1.   This communication is in response to the application filed on 11 January 2002.

Claims 1-25 are pending. The IDS statement filed 18 March 2002 has been entered

and considered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-2, 5-10, 12-17, 19-22 and 24 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Joao (6,283,761; hereinafter Joao), in view of Peterson et al.

(6,343,271; hereinafter Peterson).

(A)   As per claim 1, Joao discloses in a server system that communicates with a

client system associated with a physician and is adapted to facilitate processing of an

insurance claim, a method of delivering a supporting document to a carrier to enable the

carrier to process an insurance claim, the method comprising the acts of:

> (1)   receiving an insurance claim from the client system (Joao: abstract; col. 2,
>
>   line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7; fig. 1);
>
> (2)   storing an electronic image of the supporting document (Joao: col. 7, lines
>
>   42-61; col. 16, lines 33-37); and
>
> (3)   notifying the carrier that the electronic image is available via a web server
>
>   associated with the server system so as to enable the carrier to access
>
>   the electronic image and process the insurance claim (Joao: col. 4, lines
>
>   5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; fig. 1-2).

Joao, however, fails to _expressly_ disclose in a server system that communicates

with a client system associated with a physician and is adapted to facilitate processing

of an insurance claim, a method of delivering a supporting document to a carrier to

enable the carrier to process an insurance claim, the method comprising the acts of:

> (4)   receiving a supporting document associated with the insurance claim in an
>
>   electronic format from the client system.

Nevertheless, this feature is old and well known in the art, as evidenced by
Peterson. In particular, Peterson discloses in a server system that communicates with a
client system associated with a physician and is adapted to facilitate processing of an
insurance claim, a method of delivering a supporting document to a carrier to enable the
carrier to process an insurance claim, the method comprising the acts of:

> (4)   receiving a supporting document associated with the insurance claim in an
> electronic format from the client system (Peterson: abstract; col. 3, line 12-
> col. 4, line 20; fig. 1-11).

One of ordinary skill would have found it obvious at the time of the invention to
combine the teachings of Peterson with the teachings of Joao with the motivation of
providing a means for facilitating claim processing (Peterson: col. 3, lines 54-63).

(B)   As per claim 2, Joao discloses a method as recited in claim 1, further comprising
the act of transmitting information to the client system that causes the client system to
prompt a user of the client system to submit the supporting document associated with
an insurance claim (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col.
36, line 30; fig. 1).

(C)   As per claim 5, Joao discloses a method as recited in claim 1, further comprising
the acts of:

(1)   transmitting claim information associated with the insurance claim to a

payment entity, wherein, upon receiving the claim information, the

payment entity advances money to the client system prior to the carrier

making payment on the insurance claim (Joao: col. 37, lines 48-65; fig. 1);

and

(2)   transmitting the insurance claim to the carrier, wherein, upon receiving the

insurance claim, the carrier makes payment on the insurance claim to the

payment entity, thereby paying for the money advanced to the client

system (Joao: col. 37, lines 48-65; fig. 1).

(D)   As per claim 6, Joao discloses a method as recited in claim 1, wherein the act of

notifying the carrier comprises the act of delivering an access credential to the carrier,

the access credential being patient specific (Joao: col. 4, lines 6-10; col. 7, lines 16-24;

col. 39, lines 54-62).

(E)   As per claim 7, Joao discloses a method as recited in claim 6, wherein the

access credential is unique to the carrier (Joao: col. 4, lines 6-10; col. 7, lines 16-24;

col. 39, lines 54-62).

(F)   As per claim 8, Joao discloses a method as recited in claim 1, further comprising

the act of, upon receiving a request from the carrier, transmitting the electronic image of

the supporting document to the carrier (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(G)   As per claim 9, Joao discloses a method as recited in claim 1, further comprising the act of transmitting a request for the supporting document to the client system, wherein the supporting document is received by the server system in response to the request (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(H)   As per claim 10, Joao discloses a method as recited in claim 9, further comprising the act of selecting the supporting document based on information included in the insurance claim, wherein the act of requesting the supporting document is performed after and in response to the act of selecting the supporting document (Joao: col. 4, lines 5-11 and lines 26-33; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(I)   As per claim 12, Joao discloses a method as recited in claim 1, further comprising, prior to transmitting the insurance claim to the carrier, determining whether the insurance claim is in condition for payment (Joao: col. 3, lines 33-45; col. 6, lines 1-3; col. 7, lines 43-48).

(J)   As per claim 13, Joao discloses a method as recited in claim 12, wherein it is

determined that the insurance claim is not in condition for payment, the method further

comprising the acts of:

      (1)   prior to transmitting the insurance claim to the carrier, notifying the client

             system that the insurance claim is not in condition for payment (Joao: col.

             4, lines 5-11; col. 5, lines 7-18; col. 6, lines 1-4 and 45-61; col. 34, lines

             59-62; fig. 1-2); and

      (2)   receiving an amended insurance claim from the client system in which one

             or more errors in the insurance claim have been corrected, such that the

             amended insurance claim is in condition for payment (Joao: col. 4, lines 5-

             11; col. 5, lines 7-18; col. 6, lines 1-4 and 45-61; col. 19, lines 31-39; col.

             34, lines 59-62; fig. 1-2).

(K)   As per claim 14, Joao discloses in a client system that is associated with a

physician and communicates with a server system adapted to facilitate processing of an

insurance claim, a method of providing a supporting document to the server system to

enable a carrier associated with the insurance claim to process an insurance claim, the

method comprising the acts of:

      (1)   displaying an insurance claim form on the client system (Joao: abstract;

             col. 4, lines 11-26; fig. 1);

    (2)   receiving, at the client system associated with the institutional health care provider, user input representing patient information, insurance information, and treatment information (Joao: abstract; col. 2, line 25-col. 4, line 5; col. 4, line 59-col. 5, line 7; col. 16, lines 38-65; fig. 1);

    (3)   transmitting an insurance claim that includes the patient information, insurance information, and treatment information from the client system to the remote server computer (Joao: abstract; col. 2, line 25-col. 25-col. 4, line 5; col. 4, line 59-col. 5, line 7; fig. 1); and

    (4)   transmitting the supporting document in the electronic format from the client system (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

Joao, however, fails to _expressly_ disclose in a client system that is associated with a physician and communicates with a server system adapted to facilitate processing of an insurance claim, a method of providing a supporting document to the server system to enable a carrier associated with the insurance claim to process an insurance claim, the method comprising the acts of:

    (5)   prompting a user of the client system to provide a specified supporting document in an electronic format, wherein the specified supporting document is required to process the insurance claim (Peterson: abstract; col. 3, line 12-col. 4, line 20; fig. 1-11).

Nevertheless, this feature is old and well known in the art, as evidenced by

Peterson. In particular, Peterson discloses in a client system that is associated with a

physician and communicates with a server system adapted to facilitate processing of an

insurance claim, a method of providing a supporting document to the server system to

enable a carrier associated with the insurance claim to process an insurance claim, the

method comprising the acts of:

(5)   prompting a user of the client system to provide a specified supporting

document in an electronic format, wherein the specified supporting

document is required to process the insurance claim (Peterson: abstract;

col. 3, line 12-col. 4, line 20; fig. 1-11).

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Peterson with the teachings of Joao with the motivation of

providing a means for facilitating claim processing (Peterson: col. 3, lines 54-63).

(L)   As per claim 15, Joao fails to _expressly_ disclose a method as recited in claim 14,

further comprising the act of identifying the specified supporting document.

Nevertheless, this feature is old and well known in the art, as evidenced by

Peterson. In particular, Peterson discloses a method as recited in claim 14, further

comprising the act of identifying the specified supporting document (Peterson: abstract; col. 3, line 12-col. 4, line 20; fig. 1-11).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson with the teachings of Joao with the motivation of providing a means for facilitating claim processing (Peterson: col. 3, lines 54-63).

(M)   As per claim 16, Joao discloses a method as recited in claim 15, wherein the act of identifying the specified supporting document comprises the act of receiving a request for the supporting document from the server system (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(N)   As per claim 17, Joao discloses a method as recited in claim 14, further comprising the act of receiving data from a scanner associated with the client system, wherein the data from the scanner represents the supporting document in the electronic format and is received in response to a paper copy of the document being scanned by the scanner (Joao: col. 16, lines 3-18; col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(O)   As per claim 19, Joao discloses a method as recited in claim 14, wherein the act of transmitting the supporting document is conducted such that the carrier can process the insurance claim without any supporting documents being sent by mail (Joao: abstract; col. 3, line 33-col. 4, line 25; col. 6, lines 45-52; fig. 1).

(P)   As per claim 20, Joao discloses a method as recited in claim 19, wherein the act of transmitting the supporting document is conducted such that the server system is capable of making an electronic image of the supporting document available to the carrier (Joao: abstract; col. 3, line 33-col. 4, line 25; col. 6, lines 45-52; fig. 1).

(Q)   Claims 21-22 and 24 substantially repeat the same limitations of claims 1-20 and are therefore, rejected for the same reasons given for those claims.

4.   Claims 3, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Peterson as applied to claims 1, 14 and 21 above, and further in view of Robinson-Crowley, Christine ("Understanding Patient Financial Services" Copyright 1998. Aspen Publishers; hereinafter Robinson).

(A)   As per claim 3, Joao discloses a method as recited in claim 1, further comprising the act of determining whether the insurance claim is eligible for payment (Joao: col. 5, line 60-col. 6, line 5).

    Joao, however, fails to _express_ly disclose a method as recited in claim 1, further comprising an *advance* payment [emphasis added].

    Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further

comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao and Peterson with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

(B)   As per claim 11, Joao discloses a method as recited in claim 9, further comprising the act of notifying the client system that the insurance claim is eligible for payment, wherein the act of notifying is conducted prior to the act of transmitting the request for the supporting document (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

Joao, however, fails to _express_ly disclose a method as recited in claim 1, further comprising an _advance_ payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao and Peterson with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

(C)   As per claim 18, Joao discloses a method as recited in claim 14, further

comprising the act of receiving notification from the server system that the insurance

claim is eligible for advance payment (Joao: col. 5, lines 7-18; col. 5, line 60-col. 6, line

5, fig. 1).

Joao, however, fails to _express_ly disclose a method as recited in claim 1, further

comprising an _advance_ payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by

Robinson. In particular, Robinson discloses a method as recited in claim 1, further

comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to

read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Robinson with the combined teachings of Joao and Peterson

with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

5.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao,

Peterson and Robinson as applied to claim 3 above, and further in view of Doyle, Jr. et

al. (5,070,452; hereinafter Doyle).

(A)   As per claim 4, Joao fails to _expressly_ disclose a method as recited in claim 3,

wherein the act of determining whether the insurance claim is eligible for advance

payment comprises:

(1)   determining whether the treatment information corresponds to health care

       services that are approved for payment; and

(2)   determining whether the patient is an approved beneficiary of the carrier.

Nevertheless, these features are old and well known in the art, as evidenced by

Doyle. In particular, Doyle discloses a method as recited in claim 3, wherein the act of

determining whether the insurance claim is eligible for advance payment comprises:

(1)   determining whether the treatment information corresponds to health care

       services that are approved for payment (Doyle: abstract; col. 3, lines 5-10;

       fig. 1); and

(2)   determining whether the patient is an approved beneficiary of the carrier

       (Doyle: abstract; col. 3, lines 5-10; fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Doyle with the combined teachings of Joao, Peterson and

Robinson with the motivation of providing an improved system for the administration of

medical insurance claims (Doyle: col. 1, lines 65-67).

6.   Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao

and Peterson as applied to claim 21 above, and further in view of Doyle.

(A)   Claim 23 substantially repeats the same limitations of claim 4 and is therefore,

rejected for the same reasons given for those claims.

7.   Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao

and Peterson as applied to claims 1, 14 and 21 above, and further in view of Howes

(6,738,784; hereinafter Howes).

(A)   As per claim 25, Joao fails to _expressly_ disclose a method as recited in claim 24,

further comprising the act of transmitting a suggested revised treatment code that

corresponds to the health care services rendered to the client system.

        Nevertheless, this feature is old and well known in the art, as evidenced by

Howes. In particular, Howes discloses a method as recited in claim 24, further

comprising the act of transmitting a suggested revised treatment code that corresponds

to the health care services rendered to the client system (Howes: col. 10, lines 45-51;

col. 11, lines 24-33).

        One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Howes with the combined teachings of Joao and Peterson

with the motivation of improved medical document processing (Howes: col. 2, lines 40-

44).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure. The cited but not applied art teaches a system and method for

managing insurance claim processing (5,950,169); loans and lines of credit provided to

terminally ill individuals (US 2001/0047325); a method and apparatus for processing

health insurance applications over a network (US 2003/0083906); and automated

posting of medical insurance claims (5,235,702).

        The cited but not applied prior art also includes non-patent literature articles by

Mueller, Christopher ("Evidence: Practice Under the Rules" Copyright 1999. Aspen

Publishers. 2nd Edition.); Business Editors ("MedCom USA Inc. Names New CEO" Aug

9, 2001. Business Wire. pg. 1.); PR Newswire ("AnciCare Builds State-of-the-Art Billing

Efficiency With New eStellarNet Payer Connectivity Agreement" Apr 27, 2001. pg. 1.);

Business Editors ("VantageMed and eStellarNet Announce Strategic Relationship for

Electronic Processing of Non-Group Health Transactions" Dec 19, 2000. Business Wire.

pg. 1.); Business Editors ("MD-Online.com Appears On Alexander Haig's World

Business Review TV Series. Oct 24, 2000. Business Wire. pg. 1.); PR Newswire

("Claimsnet.com Enters Into Co-branding Partnership With Synertech®" Sep 18, 2000.

pg. 1.); Business Editors ("DrFirst.com Launches Secure Message Exchange Network

Health Care Providers; DrFirst.com solves major problem in health care industry -

securely connecting its participants" Aug 22, 2000. pg. 1.); PR Newswire

("Physiciansite.com Announces Stock & Cash Transaction Valued At Approximately $43

Million" Aug 24, 1999. pg. 1.); e-StellarNet (www.estellarnet.com @

http://web.archive.org/web/20010201203200/http://www.estellarnet.com/ Copyright

1997-2001.); MD On-Line (www.mdon-line.com @

http://web.archive.org/web/20010815084319/mdon-line.com/md_welcome.htm.

Copyright 2000.); and Claimsnet.com (www.claimsnet.com @

http://web.archive.org/web/20011217201034/www.claimsnet.com/public/. Copyright

2000.).

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mike Tomaszewski whose telephone number is

(571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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C. LUKE GILLIGAN
PATENT EXAMINER